

REMARKS

Claims 8-15 are pending in this application, with claim 15 having been added. No new matter has been added. Claims 8-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,182,553 ("Kung") in view of U.S. Patent No. 5,850,630 ("Wilson"). Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the following remarks.

I. CLAIMS 8-14 ARE NOT OBVIOUS OVER KUNG & WILSON

In support of the rejection of claims 8-14, the Examiner notes that while "Kung does not explicitly disclose operating instructions, that are able to be acoustically displayed via an output device, . . . Wilson is evidence of operating instructions, that are able to be acoustically displayed via an output device." It is respectfully submitted that the pending claims are not rendered obvious by Kung and Wilson for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, the prior art must also suggest combining the elements in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F. 2d 931, 934 (Fed. Cir. 1990); In re Bond, 910 F. 2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a prima facie case of obviousness. The Examiner must show, inter alia, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. See M.P.E.P. §2143. Applicant respectfully submits that neither of these criteria for obviousness are met here.

Claim 8 recites a "broadcast radio receiver set" that has "a memory for storing operating instructions that are capable of being retrieved, through input selection, in any desired section, and that are able to be at least acoustically displayed via an output device." First, there is simply

no motivation or suggestion to combine the teachings of Kung with the teachings of Wilson in an attempt to achieve the claimed invention. There is simply no suggestion in Kung and Wilson that task-related, sensory-instructional prompts (e.g., voiced data and instructions) for the use of a tool kit as taught in Wilson are desirable for the communications receiver disclosed in Kung. Kung describes a pager configured for the visual output of data and to receive selective ringing signals. (Col. 2, lines 22-25). Kung does not suggest that the pager may also act as a radio receiver, and does not suggest any acoustical display of data. A pager does not usually include an audio speaker, since a radio or telephone is better suited for acoustical display of data than a pager. Furthermore, while the Examiner contends that "Wilson is pertinent to the problem at hand, displaying acoustic operating instructions," it is simply illogical to suggest that audio guidance technology (e.g., voiced data and instructions) contained in a tool kit as disclosed in Wilson is similar to the visual-display capability of a communications receiver as disclosed in Kung. It should be noted that Wilson reference teaches audio guidance for the user of a tool kit to interface with, and operate, the tools provided in the kit. (Col. 2, lines 16-23). Essentially, Wilson only describes a speech synthesizer that is arranged in a first aid kit. While it is logical for a tool kit with audible prompting to have the capability to deliver audio guidance as in Wilson, it is simply illogical to incorporate an audio guidance capability for requesting search information from a user of a communications receiver as disclosed in Kung. Furthermore, the suggested combination would necessarily alter the original principles of operation of the combined references, thereby defeating the obviousness conclusion as a matter of law. MPEP 2143.01. In view of the above, it is respectfully submitted that the combination asserted by the Examiner is not supported by the applied references, and the suggested combination is insufficient to support the obviousness rejection of claim 8.

Even if one assumed that there were some motivation to make the combination asserted by the Examiner, the suggested combination would still fail to approximate the claimed invention. As noted above, claim 8 recites a "broadcast radio receiver set" that has "a memory for storing operating instructions that are capable of being retrieved . . . and that are able to be at least acoustically displayed via an output device." Wilson discloses output of audio guidance (e.g., voiced data and instructions) for a user of a tool kit to interface with and operate the tools

provided in the kit. (Col. 2, lines 16-23). Specifically, Wilson describes output of audio instructions for treatment of an injury or illness using the items included in the first aid kit. However, Wilson does not provide acoustic operating instructions. This is a fundamental difference: operating instructions provide the user with information which is independent of the state of the device, while the user audio guidance depends on the instantaneous state of the device and only provides information regarding what the next operating step is. In Wilson, the user selects a task to be performed by depressing a selector key, and then the kit produces audible and/or video signals to indicate the tools required for the selected tasks and to indicate to the user how to perform the selected task with the tools provided in the kit. (Col. 1, line 64 to Col. 2, line 7). For these reasons, the suggested combination of Kung and Wilson would not render the subject matter of claim 8 obvious, and claim 8 is allowable over the applied references.

Claims 9-14, which depend from allowable claim 8, are similarly allowable by virtue of their dependence on allowable claim 8.

In view of the foregoing, it is respectfully requested that the rejection of claims 8-14 be withdrawn.

II. CONCLUSION

In light of the foregoing, Applicant respectfully submits that all pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,
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